

The Examiner states that:

Inventions I-V and V-I, respectively are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions I-V each has a separate use relative to the others in the application of data intercept. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

In light of the remarks presented below, Applicants respectfully traverse the restriction of Groups I-V.

SUMMARY:

Applicants respectfully submit that Groups I, II, and V cannot be established as subcombinations and, thus, should be prosecuted together. Applicants respectfully submit that Groups III and IV cannot be established as subcombinations and, thus, should be prosecuted together. Applicants also respectfully submit that Groups I, II, and V are a subcombination of the combination in Groups III and IV, and restriction cannot be shown to be proper for this combination-subcombination.

GROUPS I, II, and V

Applicants respectfully submit that the claims of Groups I, II, and V cannot be established as Subcombinations Usable Together under MPEP § 806(d). MPEP § 806.05(d) states in part:

806.05(d) Subcombinations Usable Together

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other. (emphasis added).

Care should always be exercised in this situation to determine if the several subcombinations are generically claimed. See MPEP § 806.04(b).

GROUP I

1. A method of generating a plurality of custom browse hierarchies each representative of a unique subset of items, said method comprising:
 - for each leaf node of a primary hierarchy representative of the items:
 - establishing a search rule that comprises an aggregation of constraints specified by the leaf node and its ancestors; and
 - identifying all of the unique subsets that contain at least one of the items meeting the aggregation of constraints; and
 - creating a custom browse hierarchy for each of the unique subsets, said creating further comprising retaining in the custom browse hierarchy only those leaf nodes, and their ancestors, from the primary hierarchy for which the unique subset has been identified by said identifying.

GROUP II

11. An apparatus for generating a plurality of custom browse hierarchies each representative of a unique subset of items, said method comprising:
 - for each leaf node of a primary hierarchy representative of the items:
 - means for establishing a search rule that comprises an aggregation of constraints specified by the leaf node and its ancestors; and
 - means for identifying all of the unique subsets that contain at least one of the items meeting the aggregation of constraints; and
 - means for creating a custom browse hierarchy for each of the unique subsets, said means for creating further comprising means for retaining in the custom browse hierarchy only those leaf nodes, and their ancestors, from the primary hierarchy for which the unique subset has been identified by said identifying means.

GROUP V

34. A custom browse hierarchy representative of a unique subset of items, said custom browse hierarchy generated by:
 - for each leaf node of a primary hierarchy representative of the items:

establishing a search rule that comprises an aggregation of constraints specified by the leaf node and its ancestors; and
identifying all of the unique subsets that contain at least one of the items meeting the aggregation of constraints; and
creating a custom browse hierarchy for the unique subset, said creating further comprising retaining in the custom browse hierarchy only those leaf nodes, and their ancestors, from the primary hierarchy for which the unique subset has been identified by said identifying.

Applicants respectfully submit that there are no subcombinations (plural) between claims 1, 11, and 34 because their elements are identical with the exception of the “means for” language that prefaces the last three (3) elements of claim 11.

Furthermore, MPEP § 806.05(d) further states:

Only one-way distinctness is required.

The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.

Care must be taken to determine if the subcombinations are generically claimed.

Where subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required (**MPEP § 806.04(b)**).

The burden is on the examiner to provide an example.

If applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement.

Furthermore, Applicants respectfully submit that the Examiner has not provided an example of different uses of the invention claims in Groups I, II, and V as required. The Examiner states in the Office Action, p. 2, that “In the instant case, inventions I-V each has a separate use relative to the others in the application of data intercept.” However, Applicants respectfully disagree since the claimed elements are identical for claims 1 and 34 and differ only via the “means for” prefacing language of claim 11.

If the Examiner disagrees with the Applicants as to whether Groups I, II, and V recite separate subcombinations, Applicants respectfully request that the Examiner (i) identify the distinct subcombinations of Groups I, II, and V and (ii) provide specific examples of different uses for the identified subcombinations of Groups I, II, and V.

Accordingly, Applicants respectfully submit withdrawal of the restriction between Groups I, II, and V.

GROUPS III AND IV

Applicants respectfully submit that Groups III and IV cannot be established as Subcombinations Usable Together under MPEP § 806(d). For the Examiner's convenience, Applicants reproduce MPEP § 806.05(d) again in part:

806.05(d) Subcombinations Usable Together

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other. (emphasis added).

Care should always be exercised in this situation to determine if the several subcombinations are generically claimed. See MPEP § 806.04(b).

GROUP III

21. A computer program for generating a plurality of custom browse hierarchies each representative of a unique subset of items, said computer program product comprising:

a computer-readable storage medium; and

program instructions stored on said storage medium for:

for each leaf node of a primary hierarchy representative of the items:

establishing a search rule that comprises an aggregation of constraints specified

by the leaf node and its ancestors; and

identifying all of the unique subsets that contain at least one of the items meeting

the aggregation of constraints; and

creating a custom browse hierarchy for each of the unique subsets, said creating

further comprising retaining in the custom browse hierarchy only those

leaf nodes, and their ancestors, from the primary hierarchy for which the unique subset has been identified by said identifying.

GROUP IV

31. A computer system for generating a plurality of custom browse hierarchies each representative of a unique subset of items, said computer system comprising:
a memory means for storing program instructions for:
for each leaf node of a primary hierarchy representative of the items:
establishing a search rule that comprises an aggregation of constraints specified by the leaf node and its ancestors; and
identifying all of the unique subsets that contain at least one of the items meeting the aggregation of constraints; and
creating a custom browse hierarchy for each of the unique subsets, said creating further comprising retaining in the custom browse hierarchy only those leaf nodes, and their ancestors, from the primary hierarchy for which the unique subset has been identified by said identifying; and
means for processing said program instructions.

Applicants respectfully submit that there are no subcombinations (plural) between claims 21 and 31 because their elements are essentially identical except that claim 21 recites a “computer-readable storage medium and program instructions stored on said storage medium” and claim 31 recites “a memory means for storing program instructions.”

As recited above, MPEP § 806.05(d) further states:

Only one-way distinctness is required.

The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.

Care must be taken to determine if the subcombinations are generically claimed.

Where subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required (**MPEP § 806.04(b)**).

The burden is on the examiner to provide an example.

If applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement.

Furthermore, Applicants respectfully submit that the Examiner has not provided an example of different uses of the invention of claims in Groups III and IV as required. The Examiner states in the Office Action, p.2, that “In the instant case, inventions I-V each has a separate use relative to the others in the application of data intercept.” However, Applicants respectfully disagree since the relevant claimed elements are identical for claims 21 and 31.

If the Examiner disagrees with the Applicants as to whether Groups III and IV recite separate subcombinations, Applicants respectfully request that the Examiner (i) identify the distinct subcombinations of Groups III and IV and (ii) provide specific examples of different uses for the identified subcombinations of Groups III and IV.

Accordingly, Applicants respectfully submit withdrawal of the restriction between Groups III and IV.

GROUPS I-V (1st Remark)

Applicants respectfully submit that the independent claims in Groups I, II, and V can be considered as subcombinations of the independent claims in Groups III and IV. Accordingly, the criteria for restriction must be considered under MPEP § 806.05(c) not § 806.05(d). MPEP § 806.05(c) states in part:

806.05(c) Criteria of Distinctness for Combination, Subcombination, or Element of a Combination

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

Applicants respectfully submit that the subcombination of Groups III and IV are the elements of Groups I, II, and V, with the exception of the “means for” prefacing language in Group II. Accordingly, the question to be answered under MPEP § 806.05(c) is whether “

“computer-readable storage medium and program instructions stored on said storage medium” (claim 21); or

“a memory means for storing program instructions” (claim 31)

“require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness).”

Applicants respectfully submit that ““computer-readable storage medium” (claim 21) and “a memory means for storing program instructions” (claim 31) are not patentable without the subcombination of Groups I, II, and V. Thus, since claims 21 and 31 require the particulars of the subcombination of Groups I, II, and V as claimed for patentability (to show novelty and unobviousness), Applicants respectfully submit that the required two-way distinctiveness required by MPEP § 806.05(c) cannot be shown.

Accordingly, Applicants respectfully submit that restriction between Groups I, II, and V is improper, restriction between Groups III and IV is improper, and restriction between Groups I-V is also improper.